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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,475	10/16/2003	Henry Tsang	16601-2US	5443

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CANADA

EXAMINER
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MILLER, BENA B

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 08/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/685,475

Applicant(s)

TSANG, HENRY

Examiner

Bena Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

*Bena B. Miller*

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 7, 10 and 12 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Maxim (US Patent 4,347,683).

Regarding claims 1 and 7, Maxim teaches in figures 12 and 13 a device comprising a cavity (the inside of the doll), at least one aperture in the toy (fig.13), a plurality of conductive probes (1-3) and a control unit (col. 7, par. 3). The Examiner takes the position that various orientations of the doll, such as lying back, sitting forward or lying down, will cause at least one pair of the probes to be activated or deactivated sequentially (i.e., if the figure 12 is flipped upside down, the Examiner takes the position that a pair 1 and 2 will be contacted at the same time). Further, figure 12 would inherently include a power source since Maxim teaches sounds are produced from the circuitry.

Regarding claim 2, Applicant's attention is directed to claims 1 and 7 noted above.

Regarding claim 10, Maxim further teaches probes disposed within the first compartment and the aperture allowing the movement of liquid (fig. 13).

Regarding claim 12, Maxim further teaches a doll (fig.13).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Maxim's (US Patent 4,347,683) figures 12 and 13 in view of Maxim's (US Patent 4,347,683) figures 16.

Maxim teaches in figures 12 and 13 most of the elements of the claimed invention, including an enclosure (4). However, Maxim fails to teach the probe pairs exposed to the exterior of the device. Maxim teaches housing 134 of figure 16 exposed to the exterior body 120.. It would have been obvious to one having ordinary skill in the art at the time the invention was made to expose the housing to the exterior as taught by Rodger of the device of Maxim for the purpose of producing a sound once the toy is immersed in the water.

Claims 3 and 5 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Maxim (US Patent 4,347,683) in view of Rodgers (US Patent 5,989,091).

Maxim teaches in figures 12 and 13 most of the elements of the claimed invention including an enclosure (4). However, Maxim fails to teach the probe pairs exposed to the exterior of the device. Rodgers teaches a bathtub toy that includes water probes 11 and 13 that are exposed to the surface of the body of the toy (col. 3, lines 36-39) and once immersed in water, will produce a sound and light. It would have

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been obvious to one having ordinary skill in the art at the time the invention was made incorporate light and have probes that are exposed to the exterior surface as taught by Rodger in the toy of Maxim for the purpose of producing a sound and light once the toy is immersed in the water.

Claims 4 and 8 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over figures 12 and 13 of Maxim (US Patent 4,347,683) in view of figure 7 of Maxim (US Patent 4,347,683).

Maxim teaches in figures 12 and 13 most of the elements of the claimed invention except for a speaker. In figure 7, Maxim teaches a circuit which incorporates a speaker 86. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a speaker as shown in figure 7 of Maxim to the figures 12 and 13 of Maxim for the purpose of emitting sounds.

Claim 6 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Maxim (US Patent 4,347,683).

Maxim teaches in figures 12 and 13 most of the elements of the claimed invention except for a motor coupled to the control. Maxim suggests in col. 5, par. 3 that a motor 87 can be incorporated in the doll. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a motor in the toy of Maxim for the purpose of actuating a portion of the doll (col. 5, par. 3).

Claim 9 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Maxim (US Patent 4,347,683).

Maxim teaches in the figures most of the elements of the claimed invention, except for the device forming a physical partition. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the device form a physical partition, a first and second compartment, since it has been held that construction a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlicman*, 168 USPQ 177, 179.

Claim 11 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Maxim (US Patent 4,347,683) in view of Cerda et al (US Patent 5,738,526).

Maxim teaches in figures 12 and 13 most of the elements of the claimed invention except for a speaker disposed with the second compartment (Note: the head of the doll of Maxim is the second compartment as noted above) and a hole. Cerda et al teaches a doll having a speaker 49 (fig. 1 and 2) in the head of the doll and an aperture 26 located in the head to allow sound to emanate from the mouth. It would have been obvious to one having ordinary skill in the art at time the invention was made to incorporate hole and a speaker in a second compartment as taught by Cerda et al of the toy of Maxim for the purpose of providing a more intense audible sound emanating for the toy.

Claims 13, 14, 16, 19, 20, 22 and 24 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Maxim (US Patent 4,347,683) in view of Barkhoudarian (US Patent 5,040,415).

Maxim teaches in the figures 12 and 13 most of the elements of the claimed invention except for a plurality of conductive probe pairs disposed within the conduit.

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Barkhoudarian teaches a system that monitors the fluid flow within a conduit, a liquid flow (Abstract, lines 2 and 3). Regarding claims 13 and 20, Barkhoudarian further teaches in col. 1, par. 2 that it is known in the prior art to have "probes mounted to extend through ports in a flow conduit into direct contact with the fluid flow". It would have been obvious to one having ordinary skill in the art at the time the invention to dispose the probes of Maxim in the conduit as taught by Barkhoudarian for the purpose of monitoring the flow parameters of the liquid in the toy.

Regarding claim 19, Maxim and Barkhoudarian teach most of the elements of the claimed invention except for a motor coupled to the control. Maxim suggests in col. 5, par. 3 that a motor 87 can be incorporated in the doll. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a motor in the toy of Maxim and Barkhoudarian for the purpose of actuating a portion of the doll (col. 5, par. 3).

Claim 15 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Maxim (US Patent 4,347,683) in view of Barkhoudarian (US Patent 5,040,415) as applied to claim 13 above, and further in view of Llorens (US Patent 6,790,121).

Maxim and Barkhoudarian teach most of the elements of the claimed invention except for conduit with a valve. Llorens teaches doll having a valve 68 located on the conduit 44 of the doll to control the flow of the liquid (col. 5 par. 4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a valve as taught by Llorens in the conduit of Maxim and Barkhoudarian for the purpose of controlling the flow of the liquid in the toy. Further, it would have been

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obvious to one having ordinary skill in the art at the time the invention was made to have the valve disposed between the reservoir and the second end, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse* 86, USPQ 70.

Claims 17 and 21 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Maxim (US Patent 4,347,683) in view of Barkhoudarian (US Patent 5,040,415) as applied to claims 13 and 20 above, and further in view of figure 7 of Maxim (US Patent 4,347,683).

Maxim and Barkhoudarina teach most of the elements of the claimed invention except for a speaker. In figure 7, Maxim teaches a circuit which incorporates a speaker 86. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a speaker as shown in figure 7 of Maxim to the toy of Maxim and Barkhoudarian for the purpose of emitting sounds.

Claim 18 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Maxim (US Patent 4,347,683) in view of Barkhoudarian (US Patent 5,040,415) as applied to claim 13 above, and further in view of Rodgers (US Patent 5,989,091).

Maxim and Barkhoudarian teach in figures 12 and 13 most of the elements of the claimed invention except for a light emitter. Rodgers teaches a bathtub toy that includes water probes 11 and 13 that are exposed to the surface of the body of the toy (col. 3, lines 36-39) and once immersed in water, will produce a sound and light. It would have been obvious to one having ordinary skill in the art at the time the invention was made incorporate light emitter as taught by Rodger in the toy of Maxim and



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Barhoudarian for the purpose of producing a sound and light once the toy is immersed in the water.

Claim 23 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Maxim (US Patent 4,347,683) in view of Barkhoudarian (US Patent 5,040,415) as applied to claim 20 above, and further in view of Cerda et al (US Patent 5,738,526).

Maxim and Barkhoudarian teach in figures 12 and 13 most of the elements of the claimed invention except for a speaker disposed with the second compartment (Note: the head of the doll of Maxim is the second compartment as noted above) and a hole. Cerda et al teaches a doll having a speaker 49 (fig. 1 and 2) in the head of the doll and an aperture 26 located in the head to allow sound to emanate from the mouth. It would have been obvious to one having ordinary skill in the art at time the invention was made to incorporate hole and a speaker in a second compartment as taught by Cerda et al of the toy of Maxim and Barkhoudarian for the purpose of providing a more intense audible sound emanating for the toy.

### ***Response to Arguments***

Applicant's arguments filed 05/06/05 have been fully considered but they are not persuasive. In response to Applicant's remarks that Maxim fails to teach any circuit of identifying a sequence of operation; however, the Examiner disagrees. As taught in col. 7, par. 3, Maxim teaches that when the doll is oriented in different positions, the probes are contacted to provide different characteristics and functions. Once the probes are contacted, the Examiner takes the position that the circuitry will register the activation and produce a sound. Further, Maxim teaches a plurality of probes and as noted

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above, the at least a pair probe of Maxim will be activated by the liquid to produce a sound

In response to Applicant's remarks that Maxim and Rodgers fails to teach or suggest the "device is adapted for mounting in an enclosure having an opening.", Applicant's attention is directed to the above rejection.

In response to Applicant's remarks that Maxim fails to show the device dividing a cavity in the body of the toy, the Applicant's attention is directed to the above rejection.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Barkhoudarian teaches that it is known to provide probes within a conduit measure either the liquid flow, temperature or pressure of the liquid.

In reference to Applicant's remarks that Maxim, Barkhoudarian and Llorens fails to teach or suggest the limitations of claim 15, the Applicant's attention is directed to the above rejection.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bena Miller whose telephone number is 571.272.4427. The examiner can normally be reached on Monday-Friday.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Bena Miller  
Examiner  
Art Unit 3725

bbm  
August 10, 2005